

REMARKS

Summary of the Office Action

The application is subject to a Restriction Requirement between claims 1-14 and 20, drawn to a drill body, and claims 15-19, drawn to a method of manufacturing a drill body. Claims 15-19 are withdrawn from consideration.

Claim 7 is objected to because of an informality.

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,860,773 to Blomberg et al. ("Blomberg").

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,019,553 to Yakamavich, Jr. ("Yakamavich").

Claims 1 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,969,699 to Kleine.

Claims 1, 2 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,515,230 to Means et al. ("Means").

Claims 1, 10, 11 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,595,305 to Dunn et al. ("Dunn").

Claims 1, 10, 12 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,948,890 to Svensson et al. ("Svensson").

Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yakamavich in view of Blomberg.

Claims 1-8 and 10-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending U.S. Patent Application No. 10/849,447 to Lindblom.

Summary of the Response to the Office Action

The election of claims 1-14 and 20, in response to the telephonic Restriction Requirement of 14 August 2006, is affirmed. Of course, Applicants reserve the right to file during the pendency of the present application a divisional application directed to the subject matter recited in non-elected claims 15-19.

Claims 2, 4-7 and 15-19 have been cancelled without prejudice or disclaimer.

Claims 1, 3, 8, 10, 13 and 20 have been amended to particularly point out and distinctly claim the subject matter that Applicants regard as their invention.

Claims 9, 11, 12 and 14 remain as originally filed.

New claims 21-23 have been added. Support for these newly added claims may be found in the specification as originally filed at, for example, paragraph 0037.

Accordingly, claims 1, 3, 8-14 and 20-23 are pending for consideration.

All Claims Define Allowable Subject Matter

The rejections of independent claims 1 and 20 under §§ 102(b) or 102(e) as being anticipated by Blomberg, Yakamavich, Kleine, Means and/or Dunn are respectfully traversed in view of the above amendments and the following comments.

Amended claim 1 recites a drill body including, *inter alia*, a “front head including a first material” and a “cutting edge including a second material integrally sintered with the first material of the front head.” Similarly, amended claim 20 recites a deep-hole drilling tool including, *inter alia*, a drill body that includes a “front head including a first material” and a “cutting edge including a second material integrally sintered with the first material of the front head.” Support for these combinations of features may be found in the specification as originally filed at, for example, paragraphs 0036 and 0037. Thus, according to paragraph 0010 of Applicants specification as originally filed, an edge-carrying drill body eliminates the need for complementary mounting of separate cutting inserts.

In contrast, Blomberg, Yakamavich, Kleine, Means and Dunn all fail to teach or suggest each and every feature recited in amended independent claims 1 and 20. Blomberg shows a drilling tool 1 wherein “that cemented carbide inserts [10A,10B,10C] are therefore soldered or brazed in the cutting pockets [7,8,9]” (*see* Blomberg column 2, line 67, to column 3, line 1). Yakamavich states that “[a] cutting insert 60, which is brazed in a recess 54 formed in the front face 52, includes a body formed of a harder material than the steel drill body” (column 2, lines 55-57). Kleine states that a “cutting tool with its guiding abutments, which in known manner is made from a material harder than that of the drill head 10, is secured to the latter for instance by brazing” (column 2, lines 19-22). Means shows a mining roof bit drill which has a body 20 including “two prongs 24,26 which project to the working end of the bit, each having a diametrical side slot 28 in which is located one end of a hard metal cutting insert 30 brazed in

place” (*see* Means column 2, lines 63-67). And Dunn states that “[r]eferring to the assembled roof bit 20, it is typical that the hard insert 56 is brazed to the axial forward end 24 of the bit body 22” (column 5, lines 18-20).

Thus, it is respectfully submitted that Blomberg, Yakamavich, Kleine, Means and Dunn all fail to teach or suggest each and every feature recited in amended independent claims 1 and 20, and that the rejections under 35 U.S.C. §§ 102(b) and 102(e) should be withdrawn.

The rejection of independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by Svensson is respectfully traversed in view of the following comments. Svensson has an effective filing date of 10 May 2004, i.e., subsequent to the 20 May 2003 filing date of Sweden Patent Application No. 0301456-0, from which the present application claims the benefit of priority under 35 U.S.C. 119. Attached herewith is an English language translation of Sweden Patent Application No. 0301456-0, together with a statement that the translation of the certified copy is accurate. Thus, in accordance with 37 C.F.R. § 1.55(a)(4)(ii) and M.P.E.P. § 201.15, it is respectfully submitted that Svensson does not qualify as prior art, and that the rejection of claim 1 under 35 U.S.C. § 102(e) should be withdrawn.

For at least any of the above reasons, it is respectfully submitted that independent claims 1 and 20 are allowable.

Claims 3 and 8-14 depend, either directly or indirectly, from claim 1 and thus recite the same allowable combinations of features, as well as reciting additional features that further distinguish over the applied prior art. Therefore, it is further respectfully submitted that the rejections under 35 U.S.C. §§ 102(b) and 102(e) of claims 3 and 8-14 should also be withdrawn and that these claims are also allowable.

The rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Yakamavich in view of Blomberg is respectfully traversed in view of the following comments.

As discussed previously with regard to claim 1, from which claims 8 and 9 indirectly depend, neither Yakamavich nor Blomberg teach or suggest all of the recited combination of features. For example, both Yakamavich and Blomberg fail to teach or suggest “at least one cutting edge made integrally with the body and in its entirety being manufactured from a single homogenous material.” For at least this reason, it is respectfully submitted that the rejections under 35 U.S.C. § 103(a) of claims 8 and 9 should also be withdrawn and that these claims are also allowable.

With regard to the provisional nonstatutory double patenting rejections in view of Lindblom, the Office Action asserts that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same claimed subject matter.” These rejections are respectfully traversed in view of the following comments.

First, it is respectfully submitted that the Office Action has confused domination and double patenting, which are separate issues. As discussed in M.P.E.P. § 804(II), one application “dominates” a second application when the first application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another application. Further, “domination” by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection.

Second, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness. As discussed in M.P.E.P. § 804(II)(A)(1), any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. It is respectfully submitted that the Office Action has failed to accurately determine the differences between the inventions defined in the conflicting claims, and therefore has also failed to make clear the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in the claims of Lindblom. For example, Lindblom’s independent claim 1 recites a drill body including, *inter alia*, “a front mouth bridged over by a bridge on which a plurality of cutting edges are disposed” and “a plurality of chip inlets disposed in front of respective cutting edges with reference to a direction of rotation of the body.” In contrast, claim 1 of the present application recites neither a bridge, a plurality of cutting edges, a plurality of chip inlets, nor any disposition of cutting edges with respect to chip inlets. Accordingly, the Office Action fails to make clear the reasons why these differences would have been obvious a person of ordinary skill in the art.

For at least any of the above reasons, it is respectfully submitted that the rejections of claims 1, 3, 8 and 10-14 under nonstatutory double patenting grounds should be withdrawn, and that the claims are allowable over Lindblom.

New claims 21-23 depend, either directly or indirectly, from independent claim 1 and thus recite the same allowable combinations of features, as well as reciting additional features

that further distinguish over the applied prior art. Therefore, it is further respectfully submitted that these claims are also allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the pending claims are in condition for allowance, and respectfully request withdrawal of all outstanding rejections, and request the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response; the Examiner is invited to contact the undersigned representative to expedite the prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: 27 November 2006

By:

A handwritten signature in cursive script, reading "Scott J. Anchell", is written over a horizontal line.

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